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EXAMINER

DIVINE, LUCAS

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,141

Applicant(s)

KING ET AL.

Examiner

Lucas Divine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because the word network is missing a 'k' in Fig. 1, item 12.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, *the method step f) of claim 9 and step g) of claim 17 and the internet service provider of the customer of claim 13* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 1, 9, and 17 objected to because of the following informalities: in step a), Examiner believes the word 'on' should be 'of', therefore reading as 'scanning a first image data of an original'. Since scanning takes scans images and converts it into image data, it is unclear how image data would be scanned 'on' an original, thus Examiner believes a grammatical mistake has been made. Appropriate correction is required.

4. Claims 9 and 17 are objected to because of the following informalities: Examiner believes that the phrase 'transmitting the particular image data to order' indicates generating an order for the particular image data in accordance with applicant's description of orders on page 17, middle paragraph – the explanation of step S10. The claim reads that the particular image data (higher compression data) is transmitted from the second (client) terminal to the first (laboratory) terminal, which is impossible based on the claim because the client never received the high resolution data, just a compressed (e.g. thumbnail) version of it. In the previous limitation, it is discussed that a user selects the image data for printing based on the compressed version. Based on this description, the fact that the client never has high resolution to transmit to the lab in the claim, and the description of what is included in the order in applicant's specification, Examiner believes that applicant is referring to (paraphrased) *transmitting an order to the laboratory from the client based on the selections of particular image data to print or download*. Subsequently, the claim will be interpreted as so in the rejections below. Appropriate correction is required.

Claim Rejections - 35 USC § 112

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6 – 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 includes downloading an image data. Claim 1 discloses first and second image data. Therefore it is indefinite which of these image data are being referred to in claim 6 for downloading. Claims 7 and 8 are rejected for inheriting the rejected limitation.

Note: in interpreting the claim below, Examiner interprets the image data of claim 6 to be the first image data of claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 4, 5, 6, 7, 9 11, 12, 14, 16, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe et al. (US 6762860).

Regarding claim 1, Watanabe teaches a **print ordering method comprising the steps**
of:

a) scanning (by 7 or 10, Fig. 1) **a first image data on an original** (Fig. 2 shows film 13 being scanned, col. 1 line 23, col. 4 lines 41-42 and 55-56),

b) storing (by 8 or 12, Fig. 1) **the scanned first image data on a first storage member** (scanned image data is stored on servers 8 [includes 18] or 12 [includes 16] – col. 4 lines 57-59 discuss storing the image data in high resolution database 18),

c) transmitting (by 8 and 12, Fig. 2) **a second image data corresponding to the first image data from a first terminal to a second terminal through a network** (compressed image data is transmitted through the network 5 through center server 12 to user's personal computer 6, Fig. 2),

d) selecting (by user at terminal 6 through 21, Fig. 1) **an image data to be printed from the second image data** (requesting services based on downloaded thumbnails [col. 5 lines 8-20]),

e) transmitting (by 6, Fig. 1) **an information of the image data to be printed to order the print from the second terminal to the first terminal** (14, Fig. 2 – printing order [col. 1 line 15]; col. 5 lines 22-27 - order transmitted from user terminal 6 through center server 12 to laboratory server 8), **and**

f) making (by 9 or 11, Fig. 1) **a print based on the scanned first image data stored in the first storage member which corresponds to the information of the image data to be printed** (block 20 analyzes the order 14 and locates the high resolution data in 18 to be output to printer by output 19, Fig. 2; col. 5 lines 33-40 and prints).

Regarding claim 2, which depends from claim 1, Watanabe teaches **the original is a photographic film or a hard copy** (13, Fig. 2).

Regarding claim 4, which depends from claim 1, Watanabe teaches **the second image data is compressed from the first image data** ('low resolution data' is generated and sent to the user, Fig. 2, col. 4 lines 55-65).

Regarding claim 5, which depends from claim 1, Watanabe teaches **the steps a), b), c) and f) are taken place at a processing laboratory** (the items that perform a, b, c, and f are 7, 8, 8, and 9 (e.g.), respectively, and all are at the processing laboratory, Fig. 1).

Regarding claim 6, which depends from claim 1, Watanabe teaches **the step of selecting an image data to be downloaded to a second storage member** (col. 5 line 14, wherein one of the services offered by the system is being able to download the high resolution image data to the computer 6, which as a PC, inherently includes memory).

Regarding claim 7, which depends from claim 6, Watanabe teaches **the image data to be downloaded is downloaded at higher resolution than the second image data** (col. 5 lines 14-15 teach the ordering of services of the 'registered images' which refers to the high resolution images).

Regarding claim 9, Watanabe teaches a **method for ordering a print and sending an digital image from a processing laboratory** (laboratories seen in Fig. 1) **having a first terminal** (e.g. 8, Fig. 1) **to a customer having a second terminal** (e.g. 6, Fig. 1) **through a network** (e.g. 5, Fig. 1), **comprising the steps of:**

a) scanning (e.g. by 7 or 10, Fig. 1) **an image data on an original** (Fig. 2 shows film 13 being scanned, col. 1 line 23, col. 4 lines 41-42 and 55-56)

b) linking the scanned image data with a customer identification information (by 17, Fig. 2; col. 1 lines 64-65; col. 2 lines 28-29; col. 4 lines 43-48; col. 4 lines 56-58; and throughout, the correlation between customer information linking to image data is one of the key inventive features of Watanabe [col. 5 line 50 – col. 7 line 15], wherein the registration id is given to a customer so they may be identified as linked with the particular image data, further, col. 3 lines 58-63 teach the registration ids can be specifically associated with a particular user id, thus linked to a specific customer),

c) storing the scanned image data on a first storage member (scanned image data is stored on servers 8 [includes 18] or 12 [includes 16] – col. 4 lines 57-59 discuss storing the image data in high resolution database 18) **installed at a location accessible for a person in the processing laboratory** (from Fig. 1, it appears that servers 8 are located physically at the lab and server 12 is accessible to the person at the lab via network),

d) transmitting (Fig. 2) **a compressed image data** (low resolution image, Fig. 2; col. 5 lines 1-3) **obtained by compressing the scanned image data** (col. 4 lines 57-64 ‘generating low resolution data’) **from the first terminal to the second terminal through the network**

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(compressed image data is transmitted through the network 5 through center server 12 to user's personal computer 6, Fig. 2),

e) selecting, by the customer, (through browser 21, col. 5 lines 8-20) a particular image data which the customer needs to print or download (printing and downloading are both services of the system – col. 5 line 14) from the compressed image data transmitted to the second terminal (requesting services based on downloaded thumbnails [col. 5 lines 15-20]),

f) transmitting the particular image data to order (14, Fig. 2 – printing order [col. 1 line 15]; col. 5 lines 22-27) for printing the particular image data from the second terminal to the first terminal (order transmitted from user terminal 6 through center server 12 to laboratory server 8, Fig. 2),

g) selecting the scanned image data (block 20 analyzes the order and locates the data in 18 to be output to printer by output 19, Fig. 2; col. 5 lines 33-40) stored in the first storage member (high resolution image data, 18 inside 8; col. 5 line 36) according with the particular image data transmitted from the second terminal (based on order file 14; col. 5 line 33), and

h) printing (by printer 9 or 11 'outputs a print' col. 4 line 28) at the processing laboratory (located in lab 3 or 4, Fig. 1) the selected image data stored in the first storage member (high resolution data is used in printing; col. 5 lines 39-40).

Regarding claim 11, which depends from claim 9, Watanabe teaches **the second terminal has a second storage member for storing the image data to be downloaded from the first terminal (it is inherent that a PC 6 would have processor and memory for storing the data to be displayed and to be downloaded, this could be cache, RAM, hard disk, etc.).**

Regarding claim 12, which depends from claim 11, Watanabe teaches **the image data to be downloaded is higher resolution than the compressed image data from the first terminal to the second terminal** (col. 5 lines 14-15 teach the ordering of services of the 'registered images' which refers to the high resolution images).

Regarding claim 14, which depends from claim 12, Watanabe teaches **the image data to be downloaded is downloaded to the second storage member installed at the customer's home** (it is implied that the user is at the workstation 6 and the downloading referred to in col. 5 line 15 is to the workstation 6 that the user is using).

Regarding claim 16, which depends from claim 14, Watanabe teaches **the compressed image data is transmitted in the form of thumbnail index** (col. 4 lines 59-60; Fig. 7).

Regarding claim 17, the limitations of claim 17 are the same as those of method claim 9 except the limitation listed below. Therefore, Watanabe anticipates claim 17 as discussed in the rejection to method claim 9 above.

Watanabe further teaches **reprinting at the processing laboratory the selected image data stored in the first member** (it is inherent that the system provides reprinting [col. 1 line 18 and col. 4 line 41 teach that the user can do a first print when they drop off the film and then the images are digitized and they can select reprints; further, the inventive concept of Watanabe is addressed to help solve problems of requesting reprints]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe as applied to claim 1 above, and further in view of Mizumo (US 6727973).

Regarding claim 3, which depends from claim 1, while Watanabe teaches inputting and printing based on a user order, Watanabe does not specifically teach **sending the information that picking up the prints is ready from the first terminal to the second terminal**.

However, Mizumo specifically teaches a photofinishing system like that of Watanabe including **sending the information that picking up the prints is ready from the first terminal to the second terminal** (P6, Fig. 10; P8, Fig. 11; Fig. 22-24, wherein a screen notifying the completion of the order is transmitted to the user).

It would have been obvious to one of ordinary skill in the art that a user would want to know when their prints are done. The motivations for doing so would have been to allow the user to most promptly pick up the order of photo prints. Other motivations are well known in the photofinishing/online printing art.

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8. Claims 8, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe as applied to claims 6 and 12 above, and further in view of Parry et al. (US 20030076528).

Regarding claim 8, which depends from claim 6, while Watanabe teaches the downloading of high resolution image files, Watanabe does not specifically teach downloading them to an **Internet Service Provider**.

However, Parry teaches that it is well known in the art to have user images stored at **Internet Service Providers** to allow users to share their photos with each other via the Internet (paragraphs 3-8, specifically the first few lines of paragraph 4 and 5).

Therefore it would have been obvious to one of ordinary skill in the art to allow the user of Watanabe to be able to download the image data to an Internet Service Provider in order to allow sharing with friends.

Regarding claim 13, which depends from claim 12, while Watanabe teaches the downloading of high resolution image files, Watanabe does not specifically teach downloading them to an **Internet Service Provider**.

However, Parry teaches that it is well known in the art to have user images stored at **Internet Service Providers** to allow users to share their photos with each other via the Internet (paragraphs 3-8, specifically the first few lines of paragraph 4 and 5).

Therefore it would have been obvious to one of ordinary skill in the art to allow the user of Watanabe to be able to download the image data to an Internet Service Provider in order to allow sharing with friends.

Regarding claim 15, which depends from claim 13, Watanabe teaches **the compressed image data is transmitted in the form of thumbnail index** (col. 4 lines 59-60; Fig. 7).

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe as applied to claim 9 above, and further in view of Hunt et al. (US 5764235) and well known prior art.

Regarding claim 10, which depends from claim 9, while Watanabe teaches compressing and sending low resolution image data to the client for viewing and making selections for orders, Watanabe does not specifically teach **a size of the compressed image data from the first terminal to the second terminal is determined by storage capability of the second terminal and transmittance speed to the second terminal**.

However, Hunt teaches **a size of the compressed image data from the first terminal to the second terminal is determined by storage capability of the second terminal and transmittance speed to the second terminal** (Fig. 6, col. 1-14, wherein based on client image control information including bandwidth and).

It would have been obvious to one of ordinary skill in the art to adjust the compression levels depending on what clients were receiving the image in the system of Watanabe. Watanabe even displays in Fig. 1 how different users have different transmittance speeds between them and the labs. The motivation for doing so would have been to have compressed image data that can be stored, transmitted, and viewed easily for the user while still preserving the most quality as possible for the user to view. That is the basic concept behind the idea of compression in general

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for Watanabe and most online photofinishing order systems with thumbnails and similar compressed images. Further, see most of Hunt for further discussion of this idea (e.g. col. 3 lines 42-67).

Hunt teaches image control info from the user to base the compression level off of, as well as user preferences, user's conditions, etcetera. Hunt also teaches that throughout, the issue discussed is file size. *Further, Hunt teaches that the control info can include client system information including equipment data (col. 12 lines 55-60), which could include hard disk and RAM information.*

Examiner takes Official Notice that well known prior art teaches that memory size of a client is a consideration to be taken into account when considering image sizes.

It would have been obvious to one of ordinary skill in the art that client memory size could have been part of the control info for determining compression levels in the system of Hunt and Watanabe. The motivations for doing so would have been to not try to download data that the client doesn't have enough memory for. This particularly is useful with clients that are PDAs, cell phones, and other portable devices that might not have as much memory.

Conclusion

10. Examiner's note: Item c) of both claims 9 and 17 include the limitation 'storage member installed at a location accessible for a person in the processing laboratory.' Broadly read, the storage member can be accessed by a person in a processing laboratory. The claim is not clear as to if the access is a physical (I can walk up and touch the storage member) or computer access (I

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can access the storage member from the laboratory via a computer). Thus, as broadly read, prior art reading on either situation would be appropriate.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2624

ljd


KING Y. POON
PRIMARY EXAMINER